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AUG 29 2002

OFFICE OF PETITIONS

In re Application of
James H. Johnson and John
DiDomenico
Application No. 09/840,080
Filed: April 24, 2001
Attorney Docket No.
47382.000123
Title: REMOTE VEHICLE
EMISSION SENSING DEVICE
WITH SINGLE DETECTOR

DECISION ON PETITION
UNDER 37 C.F.R. §1.137(b) and
37 C.F.R. §1.47(a)

This is in response to the renewed petition under 37 CFR §1.47(b)¹, filed April 22, 2002.

The renewed petition under 37 C.F.R. §1.47(b) is **DISMISSED**.

NOTICE:

Any request for reconsideration of this decision under 37 C.F.R. § 1.147(b) must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. Failure to respond will result in abandonment of the application. The request for reconsideration should include a cover letter entitled "Second Renewed Petition

¹A grantable petition under 37 CFR 1.47(b) requires:

- (1) The petition fee;
- (2) a surcharge if the petition was not filed at the time of filing of the application;
- (3) a statement of the last known address of each of the non-signing inventors;
- (4) proof that a copy of the application was sent or given to each of the non-signing inventors for review;
- (5) proof that each of the non-signing inventors refused to sign;
- (6) proof that the Rule 47(b) applicant has sufficient proprietary interest in the subject matter to justify the filing of the application;
- (7) proof of irreparable damage, and;
- (8) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116 and 37 CFR 1.63.

under 37 C.F.R. §1.147(b)," and should only address the deficiencies noted in this decision, **except that the reply may include an oath or declaration executed by the non-signing inventor.**

Thereafter, there will be no further reconsideration of this matter^{2,3}.

The above-identified application was filed on April 24, 2001, without an executed oath or declaration and identifying James H. Johnson and John Didomenico as joint inventors. On May 10, 2001, applicant was mailed a "Notice to File Missing Parts of Nonprovisional Application - Filing Date Granted", requiring an executed oath or declaration in compliance with 37 CFR §1.63, and a surcharge for its late filing. This Notice set a two-month period for reply.

In reply, applicant filed the original petition, along with the associated fee and the fee associated with the late filing of an oath of declaration, and a declaration executed by neither inventor.

In a decision mailed on February 21, 2002, the original petition was dismissed for failure to meet requirements (3), (4), (5), and (7) above.

With the instant petition, petitioner has satisfied requirements (3) and (7) above.

With the renewed petition, the petitioner has filed a statement of the last addresses of both non-signing inventors, copies of several letters sent to the inventors, a copy of a letter sent in response from inventor DiDomenico, and a declaration of facts, executed by an employee of the assignee, which establishes irreparable harm.

Regarding the fourth requirement, petitioner has included copies of the letters sent to each of the non-signing inventors. The copy of the letter sent to inventor Johnson references the enclosure of applications 09/480,688, 09/457,391, and 09/520,166. It is noted that 09/480,688 is the grandparent of the instant application. Hence, it has been established that a copy of the grandparent to this application has been sent to the non-signing inventor.

The copy of the letter sent to inventor DiDomenico mentions the enclosure of an application. Unfortunately, the letter references application no. 09/480,699, Attorney Docket No. 47382.000039. The letter which petitioner received from the non-signing inventor referenced application no. 09/428,992. Neither of these two applications appears to be related to the instant application. As such, it is not clear how this letter can constitute evidence of petitioner's allegation that "a copy of the application was sent to each inventor for their review."⁴

² For more than a century, punctuality and due diligence, equally with good faith, have been deemed essential requisites to the success of those who seek to obtain the special privileges of the patent law, and they are demanded in the interest of the public and for the protection of rival inventors. See: Porter v. Louden, 7 App.D.C. 64 (C.A.D.C. 1895), citing Wollensak v. Sargent, 151 U.S. 221, 228, 38 L. Ed. 137, 14 S. Ct. 291 (1894). An invention benefits no one unless it is made public, and the rule of diligence should be so applied as to encourage reasonable promptness in conferring this benefit upon the public. Automatic Electric Co. v. Dyson, 52 App. D.C. 82; 281 F. 586 (C.A.D.C. 1922). Generally, 35 U.S.C. §6; 37 C.F.R. §§1.181, 182, 183.

³ If, on the second request for reconsideration, Petitioner fails to satisfy the showings burden required: (a) the resulting decision may be one viewed as final agency action; and (b) provisions for reconsideration, such as those at 37 C.F.R. §1.137(e), will not apply to that decision.

⁴ Renewed petition, page 2.

Where a refusal of the inventor to sign the application papers is alleged, the Office requires the petitioner to establish that a bona fide attempt was made to mail a complete copy of the application, which entails the specification, claims, drawings, and oath or declaration⁵. On renewed petition, it should be established that a complete copy of the application was sent to the non-signing inventor.

Regarding the fifth requirement above, it follows that since it has not been shown that a complete copy of the application was sent to the inventor, one cannot refuse to sign something which one has not seen. A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed⁶.

Further correspondence with respect to this matter should be addressed as follows:

By mail: **Commissioner for Patents
Box DAC
Washington, D.C. 20231**

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA 22202

Telephone inquiries regarding this decision should be directed to Petitions Attorney Paul Shanoski at (703) 305-0011.

Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

5 See MPEP 409.03(d).

⁶ *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).